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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,334	11/12/2003	David G. Kuehr-McLaren	RSW920010113US1	6032
46270 7590 07/08/2008 (SAUL-RSW) PATENT DOCKETING CLERK IBM Corporation (SAUL-RSW) C/O Saul Ewing LLP Penn National Insurance Tower 2 North Second Street, 7th Floor Harrisburg, PA 17101				
EXAMINER				
AUGUSTIN, EVENS J				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
07/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/706,334

**Applicant(s)**

KUEHR-MCLAREN ET AL.

**Examiner**

EVENS J. AUGUSTIN

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. In view of the appeal brief filed on 25 April 2008, PROSECUTION IS HEREBY  
REOPENED. New grounds of rejection are set forth below. Claims 1-18 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
4. Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.<sup>2</sup> If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.
5. In this particular case, the method in claim 1 is directed to non-statutory subject matter because it is not tied to another statutory class nor does the claim transform an element to a different state or thing.

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al. (U.S. 20020029201) ("Barzilai"), in view of Bowman-Amuah (U.S. 6697824) ("Bowman").
8. As per claims 1-18, Barzilai discloses an invention comprising of storage medium/software combination means (§ 42-43, 50-52 and figure 1) to perform the following:

- A. **("obtaining digitally-signed privacy-use information for each participant; ");**  
**("privacy information comprises a P3P policy ")** –The marketplace prompts the user for privacy policy information, preferably based on a standard form or language for recording privacy preferences and choices, such as an extension of the above-mentioned P3P standard (§ 12, 24, 46). Marketplace also obtains seller's privacy policy (§ 13), which has to match the buyer's;
- B. **("sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace")** – Marketplace shares buyer's privacy policy with sellers that have compatible policies (§ 14, 22, 24);
- C. The information is made available to all eligible to receive the information (i.e., buyers and sellers) (§22, 24);

**D. ("requesting each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace ")** –With regard to the registration process, Merriam-Webster's dictionary describes register as: "1 a: to make or secure official entry of in a register b: to enroll formally especially as a voter or student c: to record automatically : indicate d: to make a record of : note c: perceive;". The prior art teaches that a buyer, seeking to purchase an item of goods or services of a particular type, logs into the market maker's Web site, at a log-in step 30 (§ 54). According to Merriam-Webster's dictionary, to log is described as: "2: to make a note or record of : enter details of or about in a log ". In this case, log-in step is equivalent to the registration step because both take entries of information about the users;

**E. ("and storing all of said submitted digitally-signed privacy-use information")** – Storing information (§ 14, 79);

9. Barzilai did not explicitly describe an invention in which the privacy information received from the users is digitally signed.
10. However, Bowman describes an e-commerce environment in which information received from sender/receiver is digitally signed (Col. 68, Lines 20-26). Therefore, it would have been obvious for one skilled in the art, at the time of applicant's invention to implement digital signature in an invention that deals with privacy in an electronic marketplace.
11. The motivation for doing so would be to ensure that the identities of the sender and receiver of information in a digital marketplace are known and the information sent arrives unaltered (Bowman, Col. 70, Lines 28-34 and 58-67).

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVENS J. AUGUSTIN whose telephone number is 571-272-6860. The examiner can normally be reached on 10am - 6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571)272-6779.

/Evens J. Augustin/  
Evens J. Augustin  
July 9, 2008  
Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621